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-- REMARKS --

The present amendment replies to an Office Action dated September 7, 2005. No new matter has been added with this amendment. Claims 1, 3, 6-8, 10, 13-15, 17 and 19-20 have been amended. Claims 1, 3, 6-8, 10, 13-15, 17 and 19-20 have been amended to clarify the differences between a first user and a subscriber and not to avoid any reference. No new matter has been added to claims 1, 3, 6-8, 10, 13-15, 17 and 19-20, thus, no new search need be performed.

The Examiner rejected claims 1-4, 6-11, 13-17 and 19-21 under 35 U.S.C. § 112 first paragraph, as failing to comply with the enablement requirement. This rejection is traversed.

The Examiner rejected claims 1, 8, 15 and 21 because, "there appears to be more than one 'user'" and "because it is not clear which one of the users is 'first,' undue experimentation is required and one skilled in the art would not [know] how to make the invention" (See, page 2 of the present Office Action).

As the Examiner is well aware, "[t]here are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to: (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. (MPEP 2164.01 citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

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Citing the factors, listed above, of *In re Wands* the Court found that "[a] conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation." *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Based on the above, the Examiner has improperly concluded that the disclosure is not enabling. The Examiner has offered no analysis of the Applicant's specification in relation to any of the factors listed above. The Examiner has merely alleged that undue experimentation is required, (See page 2 of the present Office Action). Therefore, the Examiner has not fulfilled the burden of showing that the Applicant's disclosure does not meet the enablement requirement due to undue experimentation.

The Applicants' maintain that one of ordinary skill in the art would not have to undergo undue experimentation to practice the invention. One of ordinary skill in the art would not have to undergo undue experimentation to determine that the first user and the first user's moving vehicle as claimed is thoroughly described in the specification. For example, see, *inter alia*, pages 9 to 13 and FIG. 2 for an enabling and complete description of the vehicle driver and the method and system as claimed in claims 1, 8, 15 and 21. Pages 9-13 make it clear that the "first user" recited in the independent claims is the vehicle driver. Furthermore, the specification at page 12 line 29 to page 13 line 21, makes clear that the first user car pool request is compared to *other subscribers'* carpool requests.

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Additionally, the Applicants' specification is more than a "sketchy explanation of flow diagrams" illustrating the method and system as claimed. (MPEP 2106). The specification of the instant application is clear in the description of the first user having the vehicle for which positional information and route information are stored as part of the first user carpool enrollment request and other subscribers.

For these reasons, claims 1-4, 6-11, 13-17 and 19-21 contain subject matter that is described in such a manner to enable one of ordinary skill in the art to make or use the invention. Therefore, the rejection of claims 1-4, 6-11, 13-17 and 19-21 under 35 U.S.C. § 112, first paragraph should be withdrawn.

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SUMMARY

The Applicants respectfully submit that claims 1-4, 6-11, 13-17 and 19-21 fully satisfy the requirements of 35 U.S.C. § 102, 103 and 112 and are in a condition for allowance. In view of the foregoing remarks, favorable consideration and passage to issue of the present application are respectfully requested.


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Respectfully submitted,
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